

### REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on July 2, 2003. In response there to claim 1 is amended, claims 12-19 are canceled, and claims 20 and 21 are added; as a result, claims 1-10, 20 and 21 are now pending in this application. The amendments to claim 1 and claims 20 and 21 are supported by the specification. No new subject matter is added.

#### Information Disclosure Statement

Applicant respectfully requests that a copy of the 1449 Form, listing all references that were submitted with the Supplemental Information Disclosure Statement filed on October 16, 2000, marked as being considered and initialed by the Examiner, be returned with the next official communication.

#### §112 Rejection of the Claims

Claims 1-11, 13-15, 18 and 19 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner has objected to the "Z" definition in claim 1 alleging that it was not possible. Applicants submit that the claim language is both proper and would be understood by one skilled in the art. However, in order to expedite the prosecution of the instant application, claim 1 has been amended, for clarity, as suggested by the Examiner. The claim now reads that the C<sub>1</sub>-C<sub>7</sub> alkyl group is "optionally interrupted with 1-2 double bonds, 1-2 nonperoxide O or 1-2 NR wherein ..."

In addition, the Examiner has objected to the term "C<sub>6</sub>-C<sub>10</sub> heteroaryl" alleging that the claim contradicts the specification. In order to expedite prosecution, claim 1 has been amended to recite -- heteroaryl --, in the "A" definition of claim 1. The term heteroaryl is defined in the specification at page 5, lines 4 to 10. Applicants submit that, as amended, claim 1 is now consistent with the specification.

Finally, the term "amino acid ester" is defined at page 5, lines 11-13, as "the product of the reaction of a hydroxy group with the carboxy group of an N-protected amino acid." It is

respectfully submitted that the term in the claims is proper. However, in order to expedite the prosecution and move the claims to allowance, applicants have amended the term "an ester of an amino acid" to recite -- an amino acid residue -- to clarify the claim.

The Examiner is requested to note that the amendment of claim 1 as presented herein does not surrender any equivalent to which the substituents may be entitled.

Claims 11 and 13-15 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. Applicants strongly disagree with the Examiner. However, in order to expedite the allowance of claims 1-10, 20 and 21, claims 11 and 13-15 were cancelled. Applicants preserve the right to pursue these claims in a continuing application. Accordingly, the rejection is deemed moot.

Applicants respectfully request reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 112.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6968) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

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By their Representatives,

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Date November 3, 2003

By William F. Prout  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 3rd day of November, 2003.

Dawn M. Boyle

Name

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Signature